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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,543	10/17/2003	Neil P. Adams	555255012605	1148

7590 07/10/2007
John V. Biernacki, Esq.
JONES DAY
North Point
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EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
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2154

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/688,543

Applicant(s)

ADAMS ET AL.

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2154

1. The current title is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Art Rejections:

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Montville et al, U.S. pat. No. 6,356,937.

Art Unit: 2154

Per claims 1-8 and 10-14, Montville discloses a system and method of selecting messaging settings on a messaging client comprising the steps of:

- a) providing a message composition interface for composing an outgoing message, wherein the interface comprises a message portion and a messaging settings portion (see fig. 13);
- b) receiving from the messaging settings portions a messaging setting associated with the outgoing message being composed in the provided message composition interface and displaying the received message setting (see col 25, lines 1-6);
- c) receiving message setting via user's input device (see col 25, lines 6-14);
- d) transmitting the outgoing message based upon the received message setting, e.g., encryption option (see col 25, lines 9-10).

Per claims 15 and 23-24, Montville teaches utilizing a conventional computer system to implement the invention (see col 5, lines 15-19). It is noted that a conventional computer would include at least a data storage, an input device and an output device.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being clearly anticipated by Eason, U.S. pat. Appl. Pub. No. 2005/0039028.

Art Unit: 2154

Eason discloses a system and method of selecting messaging settings on a messaging client comprising:

- a) providing a message composition interface for composing an outgoing message, wherein the interface comprises a message portion and a messaging settings portion (see par. 43);
- b) receiving from the messaging settings portions a messaging setting associated with the outgoing message being composed in the provided message composition interface wherein the message setting may be set within the email system for all outgoing messages (see par. 45);
- c) displaying a selectable field in the message settings portion for the outgoing message to enable user to change/modify the setting for this particular message, i.e., it won't affect other subsequent outgoing messages (see par. 45).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville.

Per claims 15 and 23-24, Montville teaches utilizing a conventional computer system to implement the invention (see col 5, lines 15-19). Montville does not explicitly show a data storage, an input device and an output device. It is however noted that a conventional computer would include at least a data storage, an input device and an output device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize the use of such data storage, input device and output device in Montville because it would have enabled practicing Montville's invention.

Per claims 16-22, it would have been further obvious to one skilled in the art to practice Montville's invention with other known computing devices including a mobile device.

Art Unit: 2154

Conclusion:

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Friday from 7:00am to 4:00pm. The Group general information number is 571-272-2100. The Group fax number is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on 571-272-1915.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU
PRIMARY EXAMINER

Art Unit 2154
6/14/07